

USSN: 09/770,960
Atty. Docket No.: 10247
Response dated April 27, 2004
Reply to Final OA of February 27, 2004

REMARKS/ARGUMENTS

Claims 1-26 are all the claims pending in the application.

Applicants note with appreciation the Examiner's withdrawal of the §103 rejections based in part on DeLisio, *et al.*, as indicated at Sections 1-2, page 2, of the final Action.

Referring to Section Nos. 3-4 and 6, pages 2-3, of the final Action, Claims 1-4, 7, 10-13, 16, 20, and 22-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,931,327 to Liu, *et al.* ("Liu"), and Claims 14-15, 17-19 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu.

Applicants respectfully traverse these §102 and §103 rejections.

During patent examination, the broadest reasonable interpretation given to terms in the claims of the application must be consistent with the specification and the interpretation that those skilled in the art would reach.

Each of independent Claims 1 and 24-25 recites a "cold glue." Consistent with both the specification and the interpretation that would be applied by one of ordinary skill in the art, the broadest reasonable interpretation that may be given to the term "cold glue" as recited in the present claims necessarily excludes the "cold seal adhesives" disclosed in Liu.

The term "cold glue" is understood by those of ordinary skill in the art as referring to a class of materials distinct from and not including "cold seals." As evidence, Applicants are submitting herewith the executed Rule 132 Declaration of co-inventor JoAnn Squier. Ms. Squier, who has over 30 years of experience, carefully explains therein that the term "cold glue" is understood by those of ordinary skill in the art to represent a class of materials distinct from and not including "cold seals." In particular, she points out that the different functional applications of cold glue adhesives and cold seal adhesives necessitate that cold glue adhesives and cold seal adhesives have very different formulations which result in cold glue adhesives having very different inherent properties from cold seal adhesives.

The reference to a Merriam-Webster Dictionary, mentioned at page 3 of the final Action, is not relevant in that it is not indicative of the interpretation that those skilled in the art would reach.

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Furthermore, it would not have been obvious to modify Liu and arrive at the claimed invention.

There must be some motivation or suggestion to make the claimed invention in light of the prior art teachings. The mere possibility that the prior art may be modified so as to arrive at the claimed invention does not render obvious the invention unless the prior art suggested the desirability of the modification. The suggestion to modify must be "clear and particular." In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

In the present case, Liu provides no motivation or suggestion to arrive at the claimed label with cold glue adhesive.

In order for Liu to render obvious the inventions of Claims 14-15, 17-19 and 21, it would have had to have been obvious to, among other things, modify Liu by substituting the cold seals disclosed in Liu with the presently claimed cold glues. A person of ordinary skill in the art, however, would never have modified Liu by replacing the cold seals of Liu with cold glues. As mentioned previously, cold glue adhesives and cold seal adhesives have very different functional applications which necessitate that cold glue adhesives and cold seal adhesives have very different formulations and inherent properties. Cold glues would be completely useless for applications that require cold seals.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Applying the law to the facts of the present case, there can be no suggestion or motivation to modify Liu and arrive at the claimed invention because using cold glues on Liu's films would render Liu's films unsatisfactory for their intended purpose.

Accordingly, Applicants respectfully request the withdrawal of these §102 and §103 rejections based on Liu.

Referring to Sections 5-6, pages 2 and 4, of the final Action, Claims 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,897,722 to Bright in view of U.S. Patent 5,194,324 to Poirier.

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Applicants respectfully traverse this §103 rejection.

Poirier is not particular about the adhesive-receiving skin layer on the side of the core layer opposite the high gloss MDPE. Although Poirier discloses a layer C comprising 85% polypropylene homopolymer and 15% CaCO₃, Poirier also discloses at column 3, lines 5-6, that the adhesive-receiving skin layer can be a non-cavitated polypropylene.

Poirier provides no motivation or suggestion to choose a cavitated skin for the adhesive-receiving skin layer over a non-cavitated skin. The advantages of employing the claimed cavitated adhesive-receiving skin layer are completely unexpected from the combination of Bright and Poirier.

In contrast, the advantages of a label according to the inventions of Claims 25 and 26 are comprehensively demonstrated by the Examples presented at pages 14-19 of the specification, including the various tables therein. The advantages are also generally summarized at page 6, lines 7-15. The disclosed advantages are completely unexpected from Poirier or the combination of Bright and Poirier. The demonstration of unexpected results serves to rebut any alleged case of obviousness.

Furthermore, an applicant may compare the claimed invention with prior art that is closer to the invention than the prior art relied upon by the Examiner. The examples set forth in the present specification represent a comparison of representative examples of the invention of Claims 25 and 26 with prior art that is closer to the invention of Claims 25 and 26 than any actual embodiment or working example disclosed in Bright or Poirier. For example, Applicants kindly invite the Examiner to compare the results achieved by Examples 3, 6, and 9, which include an HDPE adhesive-receiving layer, and the results achieved by representative examples of the invention of Claims 25 and 26, such as Examples 4-5.

Accordingly, the withdrawal of this §103 rejection is requested.

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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